

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Cy A. Stein  
Serial No.: Not Yet Known  
(Continuation of U.S. Serial No. 09/109,614, filed  
July 2, 1998)  
Filed : Herewith  
For : OLIGONUCLEOTIDE INHIBITORS OF BCL-XL

1185 Avenue of the Americas  
New York, New York 10036  
April 11, 2001

Assistant Commissioner for Patents  
Washington, D.C. 20231  
Box: Patent Application

SIR:

PRELIMINARY AMENDMENT

Please amend the above-identified application as follows:

In the specification:

On page 1, after the title and before line 5 please insert:

--This application is a continuation of U.S. Serial No. 09/109,614,  
filed July 2, 1998, the contents of which are hereby incorporated  
by reference.--

In the claims:

Please cancel claims 1-8, 10-25 and 31 without prejudice or  
disclaimer to pursue these claims in a different application.

Please amend claims 9, 26 and 28 under the provisions of 37 C.F.R.  
§ 1.121(a)(2)(ii) by deleting the bracketed materials and inserting

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the underlined materials as follows. Attached is a marked up copy and a clean copy of these claims.

9. (Amended) [The] A composition of matter comprising an antisense oligonucleotide [of claim 3] comprising consecutive nucleotides, the nucleotide sequence of which is set forth in one of SEQ ID NOS: 1-13, wherein one or more [of the oligonucleotide's sugars] sugar of the oligonucleotide contain an -OMe group at [their] its 2' position.
26. (Amended) A method of promoting the regression of vascular lesions, comprising introducing into a vascular cell an amount of [the] a composition of matter comprising an antisense oligonucleotide [of claim 3] comprising consecutive nucleotides, the nucleotide sequence of which is set forth in one of SEQ ID NOS: 1-13, effective to reduce the levels of bcl-xL protein produced, thereby promoting the regression of vascular lesions, wherein one or more sugar of the oligonucleotide contain an -OMe group at its 2' position.
28. (Amended) The method of claim 26, wherein the introducing comprises using porphyrin [or lipofectin] as a delivery agent.

**Please add new claim 36 as follows:**

36. (New) A composition of matter comprising an antisense oligonucleotide comprising consecutive nucleotides, the nucleotide sequence of which is set forth in one of SEQ I NOS: 1-13, wherein one or more sugar of the oligonucleotide is modified at its 2' position.

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#### REMARKS

This application is a continuation of U.S. Serial No. 09/109,614 filed July 2, 1998 which names Cy A. Stein as the sole inventor. During a review of the subject matter of those claims it was determined that Paul Cossum, Robert Rando and Joshua Ojwang should be co-inventors of some of these claims with Cy A. Stein. Applicants have decided to present the claims from the '614 application in two separate applications, based on inventorship. The present application will contain claims invented solely by Cy A. Stein, and another continuation of the '614 application being filed concurrently herewith will contain claims invented jointly by Cy A. Stein, Paul Cossum, Robert Rando and Joshua Ojwang.

Upon entry of this amendment claims 9, 26, 27, 28, 29, 30 and 36 will be pending and under examination. Of these claims, claims 9, 26 and 28 are being amended, claims 27, 29 and 30 are not being amended, and claim 36 is being added. Support for the amendments and new claim 36 may be found in the specification and claims as filed in the parent application, and in Figure 1. Applicants respectfully request entry of the Preliminary Amendment.

#### Inventorship of Claims

Applicant hereby informs the Examiner assigned to the subject application of the inventors of the claims canceled from this application, amended hereinabove, and claims which remain unchanged as follows:

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<u>Claims</u>	<u>Inventor(s)</u>
1-8	Cy Stein, Paul Cossum, Robert Rando and Joshua Ojwang
9	Cy Stein
10-11	Cy Stein, Paul Cossum, Robert Rando and Joshua Ojwang
12	Cy Stein for the "lipophilic carrier" embodiment only; Cy Stein, Paul Cossum, Robert Rando and Joshua Ojwang for the remaining embodiments
13-22	Cy Stein, Paul Cossum, Robert Rando and Joshua Ojwang
23	Cy Stein for the "porphyrin as a delivery agent" embodiment only; Cy Stein, Paul Cossum, Robert Rando and Joshua Ojwang for the remaining embodiments
24-25	Cy Stein, Paul Cossum, Robert Rando and Joshua Ojwang
26-30	Cy Stein for embodiment wherein "one or more sugar of the oligonucleotide contain an -Ome group at its 2' position"; Cy Stein, Paul Cossum, Robert Rando and Joshua Ojwang for the remaining subject matter
31-35	Cy Stein, Paul Cossum, Robert Rando and Joshua Ojwang

The subject matter of new claim 36 being added herein was invented by Cy Stein.

The subject matter of new claims 36-39 being added by Preliminary Amendment in the other continuation of 09/109,614 being filed concurrently herewith was invented by Cy Stein, Paul Cossum, Robert Rando and Joshua Ojwang.

Applicant also hereby informs the Examiner that at the time the invention was conceived and reduced to practice Cy Stein was under an obligation to assign to one entity, whereas Paul Cossum, Robert Rando and Joshua Ojwang were under an obligation to assign to a

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different entity.

Applicants have hereinabove canceled without disclaimer or prejudice claims 1-8, 10-25 and 31-35, which were invented jointly by Cy Stein and Paul Cossum, Robert Rando and Joshua Ojwang. Claims 9 and 26-30 as presently worded herein were invented solely by Cy Stein.

Applicant has added new claim 36 invented solely by Cy Stein. Accordingly, the claims pending after this Preliminary Amendment are directed only to subject matter invented solely by Cy Stein. Applicants hereby inform the Examiner that the claims of presently copending application bearing U.S. Serial No. 09/109,614, filed July 2, 1998 are directed to subject matter invented solely by Cy Stein.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone at the number provided below.

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No fee is deemed necessary in connection with the filing of this Preliminary Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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Marked Up Copy of Amended Claims:

9. (Amended) [The] A composition of matter comprising an antisense oligonucleotide [of claim 3] comprising consecutive nucleotides, the nucleotide sequence of which is set forth in one of SEQ ID NOS: 1-13, wherein one or more [of the oligonucleotide's sugars] sugar of the oligonucleotide contain an -OMe group at [their] its 2' position.
26. (Amended) A method of promoting the regression of vascular lesions, comprising introducing into a vascular cell an amount of [the] a composition of matter comprising an antisense oligonucleotide [of claim 3] comprising consecutive nucleotides, the nucleotide sequence of which is set forth in one of SEQ ID NOS: 1-13, effective to reduce the levels of bcl-xL protein produced, thereby promoting the regression of vascular lesions, wherein one or more sugar of the oligonucleotide contain an -OMe group at its 2' position.
28. (Amended) The method of claim 26, wherein the introducing comprises using porphyrin as a delivery agent.

## Clean Copy of Amended And New Claims:

9. A composition of matter comprising an antisense oligonucleotide comprising consecutive nucleotides, the nucleotide sequence of which is set forth in one of SEQ ID NOS: 1-13, wherein one or more sugar of the oligonucleotide contain an -OMe group at its 2' position.
26. A method of promoting the regression of vascular lesions, comprising introducing into a vascular cell an amount of a composition of matter comprising an antisense oligonucleotide comprising consecutive nucleotides, the nucleotide sequence of which is set forth in one of SEQ ID NOS: 1-13, effective to reduce the levels of bcl-xL protein produced, thereby promoting the regression of vascular lesions, wherein one or more sugar of the oligonucleotide contain an -OMe group at its 2' position.
28. The method of claim 26, wherein the introducing comprises using porphyrin as a delivery agent.
36. A composition of matter comprising an antisense oligonucleotide comprising consecutive nucleotides, the nucleotide sequence of which is set forth in one of SEQ I NOS: 1-13, wherein one or more sugar of the oligonucleotide is modified at its 2' position.